



Paper No. 7

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JUL 12 2002

OFFICE OF PETITIONS

In re Application of
Kay, *et al.*
Application No. 10/017,478
Filed: December 14, 2001
Attorney Docket Number: 1040-3

:
: **DECISION REFUSING STATUS**
: **UNDER 37 C.F.R. §1.47(a)**
:

This is in response to the April 12, 2002 petition Under 37 C.F.R. §1.47(a).

HISTORY

Applicant filed the above-identified application on September 19, 2001, naming Robert A. Kay and Larry K. Thomas as joint inventors. However, the application as filed did not include the declaration executed as required by 37 C.F.R. §1.53.

Accordingly, on January 9, 2002, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record.¹ A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on April 13, 2002, which, with the accompanying petition for a one month extension of time, was timely.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner has failed to demonstrate that the nonsigning inventor has been provided with a complete copy of the application. Rather, Petitioner has simply demonstrated that a declaration and power of attorney were sent to the nonsignor.

¹ The statutory filing fee was also missing.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.² Under the provisions of 37 C.F.R. §1.63(b)(2), a valid declaration must "state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration." Thus, an inventor cannot make a valid declaration without having had the opportunity to review the application papers. This is why the Office requires that a copy of the papers be sent or delivered to the nonsignor before rule 47 status will be granted. Simply put, an inventor must be given the opportunity to review the entire application before a valid declaration can be made. Until such time as the application has been sent or delivered to the nonsignor, it cannot be said that the inventor has been given a *bona fide* opportunity to make the required declaration.

Petitioner is advised to consult the M.P.E.P. §409.03(d) for further information on what kind of showing is required to prove that the nonsigning inventor has refused to sign the declaration.

Because of the foregoing, this petition is *dismissed*.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

Further correspondence with respect to this matter should be addressed as follows:

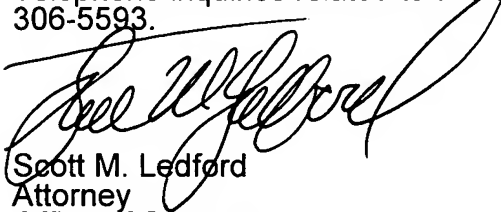
By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

² M.P.E.P. §409.03(d)

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.

A handwritten signature in black ink, appearing to read "Scott M. Ledford", is written over the printed name and title.

Scott M. Ledford
Attorney
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects